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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,544	04/17/2001	Brian Seed	11-88L	6823

23713 7590 07/02/2003

GREENLEE WINNER AND SULLIVAN P C
5370 MANHATTAN CIRCLE
SUITE 201
BOULDER, CO 80303

EXAMINER

DIBRINO, MARIANNE NMN

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 07/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/836,544

Applicant(s)

SEED ET AL.

Examiner

DiBrino Marianne

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13, 15-17, 19 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-11, 13, 15-17, 19 and 21-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. Applicant's amendment filed 12/3/01 (Paper No. 9) is acknowledged and has been entered.
2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1, 5, 7, 15-17, 19 and 24, drawn to nucleic acids encoding a cell surface antigen/functional derivatives thereof, classified in Class 536, subclasses 23.5.

Note Absent evidence to the contrary, each of the recited nucleic acid sequences encoding the cell surface antigen/functional derivatives thereof is distinct since each ligand(s) to which each of said cell surface antigens/functional derivatives thereof is specific for is not obvious over the other set of ligand(s). Therefore the instant claims 1, 5, 7, 15-17, 19 and 24 encompass hundreds of GROUPS, not species.

II. Claims 2, 3, 4, 6, 8-11, 13, 21-23 and 25, drawn to a substantially pure protein that is a cell surface antigen/functional derivative thereof, classified in Class 530, subclass 350.

Note Absent evidence to the contrary, each of the recited cell surface protein antigens/functional derivatives thereof, is distinct since each ligand(s) to which each of said protein antigens/functional derivatives thereof is specific for is not obvious over the other set of ligand(s). Therefore the instant claims 2, 3, 4, 6, 8-11, 13, 21-23 and 25 encompass hundreds of GROUPS, not species.

3. The GROUPS encompassed by (I) vs (II) are different products.

Nucleic acids and proteins are distinct because their structures are different, which require non-coextensive searches

Therefore they are patentably distinct.

4. Because these inventions are distinct for the reasons given above and the search required for any GROUP encompassed by I or II is not required for any other GROUP encompassed by I or II, and I and II have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.

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5. It is noted that the instant claims encompass a specific nucleic acid encoding a cell surface antigen/functional derivatives thereof (I), or a specific substantially pure protein that is a cell surface antigen/functional derivative thereof (II). Applicant is required to elect a specific nucleic acid encoding a cell surface antigen/functional derivatives thereof (I) (for example, SEQ ID NO: 2 encoding CD20), or a specific substantially pure protein that is a cell surface antigen/functional derivative thereof (II) (for example, CD20).

6. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).


8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marianne DiBrino whose telephone number is 703-308-0061. The examiner can normally be reached on Monday, Wednesday and Friday afternoons.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Christina Chan, can be reached on (703) 308-3973. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Marianne DiBrino, Ph.D.
Patent Examiner
Group 1640
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June 26, 2003



CHRISTINA CHAN
SUPERVISORY PATENT EXAMINER
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